



Docket No.: OHT-001
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Masayuki Itakura

Application No.: 09/991,934

Confirmation No.: 5436

Filed: November 26, 2001

Art Unit: 3683

For: VIBRATION PROOF DAMPER FORMING
METHOD AND DAMPER INTEGRATION
TYPE MECHANICAL CHASSIS

Examiner: D. C. Butler

PETITION UNDER 37 C.F.R. §1.144

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a petition under 37 C.F.R. §1.144 requesting review of an Election of Species requirement made by the Examiner within the Office Action of November 5, 2003, which has been traversed within the Response to Election of Species Requirement filed on December 5, 2003 and made final within the Office Action mailed on March 1, 2004.

The Election of Species requirement of November 5, 2003 asserts an existence of the following independent and distinct inventions:

Species I, according to figures 1A, 1B, 1C, 2, 5A, 5B, 5C, 6A, 6B, 6C;

Species II, according to figures 3A, 3B, 3C, 2, 5A, 5B, 5C, 6A, 6B, 6C;

Species III, according to figures 4A, 4B, 4C, 2, 5A, 5B, 5C, 6A, 6B, 6C.

The Election of Species requirement further asserts that no claims are generic claims.

A Response to Election of Species Requirement was filed on December 5, 2003. This Response elected with traverse the examination of the Species III invention.

In reply to the election and traversal made within the Response to Election of Species Requirement, the Office Action mailed on March 1, 2004 maintained the Election of Species requirement, making it FINAL.

Accordingly, this petition pursuant to 37 C.F.R. §1.144 is proper.

For the reasons provided hereinbelow, the Election of Species requirement made within the Office Action of November 5, 2003 is respectfully traversed.

As an initial matter, whereas figures 5A, 5B, 5C, 6A, 6B, and 6C are listed in each of the Species I-III, the specification for the above-identified application describes figures 5A, 5B, 5C, 6A, 6B, and 6C within the "Description of the Related Art" as conventional. As a result, the Election of Species requirement of November 5, 2003 fails to explain how and why conventional figures 5A, 5B, 5C, 6A, 6B, and 6C are to be associated with any of the alleged Species I-III. Accordingly, the Election of Species requirement is improper and should be withdrawn at least for this reason.

Moreover, "since requirements for restriction under 35 U.S.C. 121 are discretionary with the Commissioner, it becomes very important that the practice under this section be carefully administered." M.P.E.P. §803.01.

Claims 1-16 were originally filed within the above-identified application. Claim 1 was originally filed as an independent claim and claims 2-16 were originally filed as claims dependent upon claim 1.

In particular, originally filed claim 1 is drawn to a vibration preventing damper forming method for supporting in a vibration proof manner a mechanical chassis provided with a non-contact reading mechanism for a disc-like recording medium in a floating manner within a casing comprising the steps of: forming, of a resin, an opening side end portion of a damper housing having a holder portion in the form of a container opened at one end for holding a support shaft provided in one of the casing and a mechanical chassis and an elastic wall portion that may reduce a floating movement of a support shaft due to elastic deformation in three-dimensional directions and a vibration preventing damper forming portion of any one of the casing and the mechanical chassis, mounting the damper housing to said vibration damper forming portion by the fixture of the resin to thereby integrally form the vibration preventing damper with the any one of the casing and the mechanical chassis.

Originally filed claim 2 is drawn to a mechanical chassis including a non-contact reading mechanism for a disc-like recording medium and said vibration preventing damper formed in accordance with the forming method as recited in claim 1 on a chassis supported in a floating condition through the vibration preventing damper within the casing, further comprising a resin portion at the vibration preventing damper forming portion of the chassis, wherein the opening side end portion made of a resin material of the damper housing provided with the holder portion in the form of the container opened at one end for inserting the support shaft provided in the casing and an elastic wall portion for reducing the floating movement of the support shaft due to elastic deformation in three-dimensional directions is fixed to said resin portion, and said vibration preventing damper is formed integrally with said chassis.

The Office Communication of November 12, 2004 includes a note that the Examiner reserves the option of requiring restriction and/or election, in due course, pursuant to M.P.E.P. §821.03 or §811.

The first Office Action of November 7, 2002 included an examination on the merits of claims 1-16, while failing to set forth an Election of Species requirement. The claims

originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application. M.P.E.P. §818.02(a). In this regard, claims 1-16 were originally presented and acted upon by the first Office Action of November 7, 2002 on their merits.

M.P.E.P. §821.03 is related to claims for a different invention added after an Office Action.

The amendment filed on January 24, 2003 amended claims 1-4 and 8 and added claims 17-23. The Office Action of April 7, 2003 included an examination of on the merits of claims 1-23, but failed to require an election of species requirement based upon figures 1A-C, 2, 3A-3C, and 4A-C.

The amendment filed on August 7, 2003 canceled claim 1 and 17, amended claims 2, 6, 8, 11, 13, 15-16, 18-19, and 23, and added claims 24-26. Thereafter, the Office Action of November 5, 2003 set forth the above-noted Election of Species requirement.

Yet, the Office Action of November 5, 2003 fails to show that Election of Species requirement is based upon claims for a different invention added after a prior Office Action. Thus, M.P.E.P. §821.03 is also not applicable since the claims presented subsequent to first Office Action for examination are also based upon figures 1A-C, 2, 3A-3C, and 4A-C, either individually or as a whole.

M.P.E.P §811(a) arguably provides that restriction is proper at any stage of prosecution up to final action. But “if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” M.P.E.P. §803.

In this regard, the features found within figures 1A-C, 2, 3A-3C, and 4A-C have been previously examined on the merits. Yet, the Office Action of November 5, 2003 seeks to make

an Election of Species requirement among features found within figures 1A-C, 2, 3A-3C, and 4A-C that have already been searched and examined.

Because the features found within figures 1A-C, 2, 3A-3C, and 4A-C have been previously acted upon on merits within the Office Actions prior to the Office Action of November 5, 2003, the search and examination of an entire application can be made without serious burden.

Further note that the Election of Species requirement found within the Office Action of March 1, 2004 fails to show that the features found within originally filed claims 1 and 2 are not readable on the features found within each of the figures 1A-C, 2, 3A-3C, and 4A-C. Also note that the Election of Species requirement of March 1, 2004 fails to show that the claims present within the above-identified application subsequent to the Amendment filed on August 7, 2003 would not be readable on any of the figures 1A-C, 2, 3A-3C, and 4A-C.

In this regard, the Election of Species requirement found within the Office Action of November 5, 2003 failed to show that the claims presented subsequent to first Office Action of November 7, 2002 for examination are directed to an invention distinct from and independent of the invention previously found within the originally filed claims 1-16.

Applicant requests that the Commissioner exercise his supervisory authority under 37 C.F.R. §1.144 and withdraw this improper Election of Species requirement.

No fee is believed to be required in connection with this petition. However, if any fee is required, authorization is given to charge Deposit Account 18-0013.

For the reasons provided hereinbelow, the Election of Species requirement made within the Office Action mailed on November 5, 2003 is respectfully traversed.

No fee is believed to be required in connection with this petition.

However, if any fee is required, authorization is given to charge Deposit Account 18-0013.

Dated: January 12, 2005

Respectfully submitted,

By  

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